

**REMARKS**

Claims 1-28 are pending in this application. Claim 12 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. The Applicant appreciates the Examiner's indication of a persuasive argument for claims 15-28.

**I. Claim Rejections - 35 USC 5 112 (second paragraph)**

The Examiner stated that Claims 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner explains that Claim 15 (and dependent claims 16-28) is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The claim recites a step of comparing the product key read from the second data storage unit with the product key of the first program, however, it is not indicated or claimed where this product key of the first program comes from. As the product key, which is entered upon initial installation, is written into the second data storage unit, then it would appear according to the claim language that the only key on the system is that key itself. The claim does not recite where second product key to be compared against comes from. Furthermore, the claim does not disclose what occurs when the product keys are found to not be identical, however, the "continuing to complete the installation ..." limitation of the claim appears

to occur whether the keys are found to be identical or not. The Examiner states that in the case that they are not identical, then it is indefinite as to where the inputted product key comes from. As such, the Examiner states that the claim is indefinite and the scope of the invention cannot be reasonably ascertained. Upon examination, the Examiner notes that an incorporation of dependent claims 19 and 27 would cure the deficiencies of the independent claim.

However, according to MPEP §2172.01 states that “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. §112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).” Therefore, it is what the Applicant has described as being necessary and essential step and not the Examiner’s subjective viewpoint that is of interest. However, no such admission or statement of record was made that claim 15 is not enabling. In fact the opposite is true since claim 15 is an original claim filed with the original application. As stated by the CCPA, the subject matter set forth in the claims “must be presumed, in the absence of evidence to the contrary, to be that ‘which the applicant regards as his invention.’” *In re Moore*, 169 USPQ 236, 238 (CCPA 1971). Therefore, since there is no evidence to contrary and since claim 15 is the original claim, there is no omission as to essential matter.

## **II. Claim Rejections - 35 USC § 103**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness

under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. Claims 1, 3-5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida, in view of “Software-RAID Howto” by Vepstas. The Applicant respectfully traverses.**

1. Regarding claim 1, the Examiner states that Yoshida teaches a third program stored in the first data storage unit for reinstalling the first program, the third program reading the product key of

the first program stored in the second data storage unit, when a product key from the third program and the product key stored in the second data storage unit are identical (“such that the decryption key stored in the memory device is utilizable in decrypting the encrypted software at a time of re-installing the encrypted software” in col. 4 lines 13-15. Further, the Examiner states that this is performed by the “decryption key retrieval program” as stated in col. 6 line 27. Finally, this reinstallation occurs “when the appropriate decryption key exists in the decryption key memory unit ...” as stated in col. 11 lines 59-60, and is performed by “third computer readable program code means for causing said computer to decrypt the encrypted software ... and install a decrypted software content ...” in col. 3 lines 51-56. This third computer readable program code is contained in a computer usable medium, as discussed in col. 3 lines 37-62.)

The Examiner’s response to the arguments states that the Examiner disagrees with the Applicant’s position that Yoshida does not teach the product key from the decryption key retrieval program and the product key stored in the data storage unit being identical, and that the step of having a key on the retrieval program and checking it with the key on the storage unit is never made. In response, the Examiner states that it is noted that Yoshida discloses searching and comparing the software ID to the stored decryption key. “the decryption key retrieval by the decryption key retrieval program ... for sequentially comparing the software ID registered in the decryption key memory unit ...” in col. 6 lines 34-39. Further, when the system does not find a matching key, then it retrieves a new key, as in col. 6 lines 50-53, “when the decryption key retrieval by the decryption key retrieval program fails, that is, when the corresponding decryption key does not exist in the decryption key memory unit ...” As such, the Examiner states that Yoshida does disclose checking the memory unit

for an identical key, and retrieving the key as a result.

However, it is not just any program that is claimed, but the third program that reinstalls the first program. The third program then in Yoshida is being taught to read the product key of the first program in the second storage unit when the product key from the third program is identical with the key stored in the second data storage.

As seen in figure 2 and the related disclosure, the installer 101 includes the decryption key retrieval program being separate from the decryption and install program. The decryption key retrieval is not the same program that reinstalls the first program.

2. The Examiner states that Yoshida does not explicitly disclose the second data storage unit and the first data storage unit being separate, but that Vepstas discloses that it is well known by one of ordinary skill in the art that the utilization of multiple data storage units is beneficial in that a loss of one data storage unit does not result in a complete data loss, as alternate data can be stored on a secondary storage unit (Note page 7, section regarding RAID-4). As such, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize separate data storage units in the system disclosed by Yoshida, as this would allow the decryption information to be maintained, even in the event of a failure of the other data storage unit.

However, Vepstas discloses only that the RAID device distributes data and stores it in a plurality of disks. In Vepstas, if any one of the disk fails, the data on the remaining disks can be

to reconstruct the data that was on the failed disk. In the present invention, the program data cannot merely be reconstructed by the product key and must be restored when the program data was lost. Vepstas teaches reconstruction of data and such a teaching cannot be ignored as it is being combined.

According to MPEP §2145, “It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of Vepstas cannot be just ignored because according to MPEP §2141.02, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” Vepstas is teaching of reconstructing data and that cannot be done here with the present invention.

Reconstructing data is distinct from reinstalling a program. Therefore, one cannot just pick and choose certain parts of each reference without looking at the entire reference as a whole. The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964)). Therefore, here, Vepstas must be taken as a whole and it is not dealing with data reconstruction, which would be using a key not related and not work. The separate units are for reconstruction of data rather than reinstallation of the program with a key code. According to MPEP §706.02(j), there must be a reasonable expectation of success. Here, since there is no teaching as to the separate units being for

storage and use of the product key in an installation program, there is no reasonable expectation of success and not all the claim limitation are taught or suggested.

3. Regarding claim 3, the Examiner states that Yoshida discloses a first data storage unit comprising a first unit storing the first program, and a second unit storing the third program as claimed (Note Figure 1, items 12 and 13 and the corresponding sections of the disclosure).

The Examiner further argues in the response to the arguments that the memory region containing the decryption key memory unit is a separate “unit” from that of the main hard disk device storage “units.” Moreover, the Examiner states that the “third computer readable program code means for causing said computer to decrypt the encrypted software ... and install a decrypted software content ...” in col. 3 lines 51-56 is contained in a computer usable medium, as discussed in col. 3 lines 37-62.

However, reference 12 is the hard disk and 13 is the decryption key memory unit. The hard disk 13 is not teaching that it includes both a first program that will be reinstalled, and the third program that reinstalls the first program. The claim states reinstalling and not merely installing. The decryption key is in a memory unit on the hard disk, but there is no mention of the program to be reinstalled on the hard disk. Furthermore, there is no teaching that specific memory blocks are for the separate programs as one program could be part on one portion of the disk and the other part on another.

4. Regarding claim 11, the Examiner states that Yoshida discloses erasing the second program when the product key is stored in the second data storage unit as claimed (“the software content of this software is deleted ... while the corresponding software ID and decryption key are maintained ...” in col. 9 lines 1-4).

However, the precise teaching in col. 9 is only that “In a case of deleting a certain software, only the software content of this software is deleted by the decryption key management unit 64, while the corresponding software ID and decryption key are maintained in the ...memory unit 61. Certain software is not specifically teaching of the second program which as claimed “a second data storage unit storing a product key of the first program according to the second program” as seen in claim 1 of the present invention. Therefore, the second program as claimed is not being deleted.

Moreover, Yoshida teaches not “when” as claimed but “while” as seen in col. 9, lines 1-4.

**B. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida, in view of “Software-RAID Howto” by Vepstas, further in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as Venkatesan. The Applicant respectfully traverses.**

1. Regarding claim 7, the Examiner disagrees with the Applicant’s position that Venkatesan

does not teach or suggest the effect of direct input, and that instead Venkatesan will only remotely enter the code rather than directly entering the code. In response, the Examiner notes that nothing in the claim language precludes the ability for a user to be remote, and further, even remote entry of a product key is still considered direct entry of the key, as the user is directly entering the key into the system, be it is remote or local.

However, when entry is done by remote means as in Venkatesan, then the entry is no longer direct as it needs a remote means of entry. For example, a circuit directly connected to a second circuit does not have another unit or means in between. Here, also, a direct entry is not taught or suggested as a remote means is needed for entry.

2. Concerning claim 7, further the references fail teach or suggest providing the third program specifically with an input window when a product keys are not identical. The Examiner states that Yoshida does not explicitly disclose a user directly inputting the product key into an information input Window, but that Venkatesan discloses in an analogous product key-based installation system a user directly inputting the product key into an information input window as claimed (“will prompt the user to enter the indicia ... the user, in response to this prompt, will then manually enter, typically through a keyboard associated with computer ... the specific 25-digit alphanumeric indicia ...” in col. 7 lines 58-63).

However, in Venkatesan there is no actual teaching or in the other references that such input window is specifically when the product keys are not identical. Such a specific teaching is never made. Simply stating that Yoshida teaches of obtaining a key when the keys are not identical is not

a teaching concerning the input window itself. As mentioned above, the Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Therefore, here the specific teaching is not made by the references.

**C. Claims 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida, in view of “Software-RAID Howto” by Vepstas, further in view of the Microsoft Press Computer Dictionary, Second Edition. The Applicant respectfully traverses.**

1. Regarding claims 6, 8 and 9, the Examiner asked why a dictionary should not be used a reference. Respectfully, there is a problem in including a motivation or suggestion to modify the other references with a dictionary. If this was allowed without limitations, then all examiner would just use dictionaries to pick and choose the parts and simply state that the motivation is known in the art. If the motivation is clearly not in the other references as mentioned, then the Examiner is

stating that it is known in the art. One cannot just look to the entire dictionary as a person of ordinary skill would be expected to read an entire dictionary for motivation, but rather the definition itself is the only resource.

Then according to MPEP §2144.03 relating to “Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art” , the Applicant is allowed and must be provided proof of such motivation in the art. Therein lies the problem with using dictionaries a references as it is the right then for the Applicant to ask that an actual reference be provided that includes the motivation for claims 6, 8 and 9 and any rejection using a dictionary as a reference.

Respectfully, the rejection is problematic.

**D. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,075,862 to Yoshida et al, hereafter referred to as Yoshida in view of U.S. Patent 6,163,841 to Venkatesan et al, hereafter referred to as Venkatesan, further in view of the Microsoft Press Computer Dictionary, Second Edition. The Applicant respectfully traverses.**

1. As mentioned above, according MPEP §2144.03, the Applicant asks the Examiner to provide a reference concerning the common knowledge used in modifying the references with the dictionary.

2. In addition, concerning claim 12 as amended, the references in combination fail to teach or suggest the limitation of installing the remainder of the first program after storing the product key; initiating a reinstallation of the first program on the computer system; reading the product key from the second data storage unit; comparing the product key read from the product key storage with the product key of the first program; inputting the product key into a product key input window of the first program when the product keys are compared to be identical; and continuing to complete the reinstallation of the first program after the product key is inputted into the product key input window, with the step of comparing having the product key of the first program obtained from a third program accommodating the reinstallation of the first program, with the third program being provided with the information input window to allow a user to directly input the product key, when the product key from the third program and the product key stored in the second data storage unit being not identical with each other.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$120.00 is incurred by filing a petition for one-month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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